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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/070,275 | 03/06/2002 | Sylvia Huber | 50543 | 2893 |

7590 01/02/2003

Keil & Weinkauff
1101 Connecticut Avenue NW
Washington, DC 20036

EXAMINER

PRICE, ELVIS O

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1621

DATE MAILED: 01/02/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,275

Applicant(s)

HUBER ET AL.

Examiner

Elvis O. Price

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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DETAILED ACTION

Claims 1-7 are pending in the application.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

A statement reading, "This application is a 371 of PCT/EP00/08195, filed 8/22/2000.", should be entered following the title of the invention or as the first sentence of the specification.

Information Disclosure Statement

The information disclosure statement, filed 12/6/02, complies with the provisions of 37 CFR 1.97, 1.98 and MPEP02 § 609. It has been placed in the application file, and the information referred to therein has been considered as to the merits.

Search Report

The search report has been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

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Regarding claim 1, the phrase "can be" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

In claim 2, the variables "x", "y", and "z" are not defined. This renders the claim indefinite because it is unclear as to what is the proportion range, by weight, of the copper oxide, zinc oxide and aluminum oxide, respectively, comprised in the oxidic material.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claim 2 recites the broad recitation " $60 \leq x \leq 80\%$ ", and the claim also recites " $65 \leq x \leq 75\%$ " which is the narrower statement of the range/limitation.

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Claim 2 recites the broad recitation " $15 \leq y \leq 35\%$ ", and the claim also recites " $20 \leq y \leq 30\%$ " which is the narrower statement of the range/limitation.

Claim 2 recites the broad recitation " $2 \leq z \leq 20\%$ ", and the claim also recites " $3 \leq z \leq 7\%$ " which is the narrower statement of the range/limitation.

Claim 2 recites the broad recitation " $80 \leq x + y + z \leq 100\%$ ", and the claim also recites " $95 \leq x + y + z \leq 100\%$ " which is the narrower statement of the range/limitation.

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter: The subject matter of claims 1-7 would be allowable, if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action, for the following reasons: Applicants invention is drawn to a process for the hydrogenation of an organic compound, containing at least one carbonyl group. The inventive feature of the present invention is carrying out the hydrogenation of an organic compound (containing at least one carbonyl group) using a shaped body that is prepared by combining a mixture of pulverulent metallic copper or pulverulent cement or a mixture thereof with the oxidic material to form the said shaped body. The closest prior art of record (DD 256515 A) teaches a shaped body catalyst, which is prepared by admixing a copper oxide, zinc oxide and aluminum oxide with metallic copper powder, used for preparation of alcohols from synthesis gas (a synthetic fuel comprising of primarily carbon monoxide and hydrogen.). However, the closest prior art reference does not teach or suggest hydrogenating an organic compound (containing at least one carbonyl group) with the presently claimed shaped body. Since carbon monoxide is


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not an organic compound or carbonyl group, the presently claimed invention is unobvious over the prior art of record because there is no teaching or suggestion that would lead a person having ordinary skill in the art to replace the inorganic non-carbonyl compound (carbon monoxide), in the process of the DD 256515 A reference, with an organic compound containing at least one carbonyl compound.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elvis O. Price whose telephone number is 703 605-1204. The examiner can normally be reached on 8:30 am to 5:00 pm; Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 703 308-4532. The fax phone numbers for the organization where this application or proceeding is assigned is 703 308-4556 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.



Elvis O. Price

December 28, 2002